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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/736,118      | 12/15/2003  | Raymond C. Swann     | 7312                | 3629             |

7590

02/09/2006

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EXAMINER

A, PHI DIEU TRAN

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/736,118 | <b>Applicant(s)</b><br>SWANN, RAYMOND C. |  |
|                              | <b>Examiner</b><br>Phi D. A          | <b>Art Unit</b><br>3637                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, drawn to roof component assemblies, classified in class 52, subclass 408.
  - II. Claims 3-8, drawn to a method of making a self-adhered roof system, classified in class 52, subclass 748.1.
  - III. Claims 9-14, drawn to a self-adhered roof system, classified in class 52, subclass 518.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using the product; for example, the component assemblies can be used to form an outer layer for a wall.
3. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process; for example, the

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base and the cap sheet being pre-adhered offsite and then transported and lay on the roof as a finished product.

4. Because these inventions are distinct for the reasons given above and the search required for Group I or II is not required for Group III, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Robert Tousler on 2/3/06 a provisional election was made without traverse to prosecute the invention of group I, claims 1-2. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zanchetta et al (6696125).

Zanchetta et al discloses an assembly of roof components comprising a base sheet assembly, the base sheet assembly consisting essentially of a waterproof self-adhering base sheet (col 1 lines 34-35, 48-49, 59-60, col 5-6 lines 63-5), a bottom surface release sheet (col 1 line 48-49, and col 5 lines 28-30) forming a bottom surface of the base sheet assembly, the waterproof self-adhering base sheet having a length, a width and a thickness, the base sheet having a bottom

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major surface and a top major surface defined by the length and the width of the waterproof self-adhering base sheet, the base sheet consisting essentially of a reinforcing layer encapsulated within a self-adhering bitumen that forms the bottom major surface and the top major surface of the base sheet, the bottom surface release sheet overlying and being substantially co-extensive with the bottom major surface of the base sheet to protect the bottom major surface of the base sheet, a cap sheet assembly consisting essentially of a waterproof fire-retardant cap sheet adhered to an underlying roof system layer formed by a plurality of the base sheets, a bottom surface release sheet (19) forming a bottom surface of the cap sheet assembly, a top surface selvage edge portion (13, 16) release sheet forming one lateral edge portions of a top surface of the cap sheet assembly, the cap sheet having a length, a width, and a thickness, the cap sheet having a bottom major surface and a top major surface defined by the length and the width of the cap sheet, the cap sheet consisting essentially of a reinforcing layer(4) encapsulated within a fire-retardant modified bitumen which forms the bottom major surface and a selvage edge portion of the top major surface of the cap sheet, a top major surface coating layer (9) forming a remainder of the top major surface of the cap sheet, the bottom surface release sheet overlying and being substantially co-extensive with the bottom major surface of the cap sheet to protect the bottom major surface of the cap sheet, the top selvage edge portion release sheet overlying and being substantially coextensive with the selvage edge portion of the top major surface of the cap sheet.

Zanchetta et al does not show the base sheet having a top release sheet covering the top surface thereof.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Zanchetta et al's structure to show the base sheet having a top release sheet

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covering the top surface thereof because having the top release sheet would protect the top surface of the base from adhering to other structure or be contaminated before final application; furthermore, covering the top surface of the base sheet would have been a repetitive function of covering the bottom surface of the sheet, and such a repetitive function has been held to be within one of ordinary skill in the art.

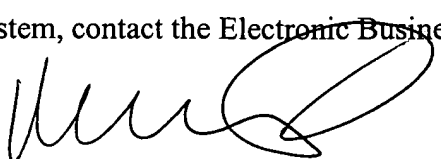
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different self-adhered roofing material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A  
2/4/06